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**IN THE
Supreme Court of the United States**

October Term, 1938

No. 166

THE TOLEDO PRESSED STEEL COMPANY,
Petitioner,

vs.

STANDARD PARTS, INC.,
Respondent.

No. 167

THE TOLEDO PRESSED STEEL COMPANY,
Petitioner,

vs.

HUEBNER SUPPLY COMPANY,
Respondent.

No. 603

MONTGOMERY WARD & COMPANY,
Petitioner,

vs.

THE TOLEDO PRESSED STEEL COMPANY,
Respondent.

**SUPPLEMENTAL BRIEF ON BEHALF OF THE
TOLEDO PRESSED STEEL COMPANY**

WILBER OWEN,
*Solicitor for The Toledo Pressed
Steel Company.*

SAMUEL E. DARBY, JR.,
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I. CONTROVERSIAL QUESTIONS OF FACT

Opponents' briefs raise several fact issues requiring consideration.

(a) History of the Torch Industry

Under this heading petitioner in the New York case attributes the first sheet steel pot torch to McCloskey and

intimates that the Toledo Company took some unfair advantage of him. It appears at pages 77 and 82 of the Ohio record that McCloskey originally sold torches for the Toledo Company and later secured outside financial help in securing the patent therefor in his own name. Mr. Close testified (Ohio R. 82):

"When we originally went into the matter, we made a torch that we had developed. That torch we manufactured and he sold."

Another misstatement in the discussion under this heading is that during the period 1929 to 1933 burners of the patented type here involved were used only for construction work and that their use as warning signals for parked trucks and busses began with the passage of an Iowa law in 1933. The tabulation on page 15 of the Montgomery Ward brief indicates that the Toledo Company's truck flare (Exhibit 19) was not manufactured and sold until 1934. This is directly contrary to the evidence.

The first sale of the Toledo Company's Economy truck flares was made on October 16, 1929. These flares were known as the Model F, were smaller than the Economy torch and were made particularly for trucks. The Model F flare was produced as a result of a report received from a dealer in Michigan calling the Toledo Company's attention to a Michigan law or order requiring trucks to carry torches as warning signals when parked on the road at night.⁽¹⁾ This Model F flare was illustrated in plaintiff's first flare circular, one of which is bound in the Ohio record at page 184. In that circular there is printed a letter from the Michigan Public Utilities Commission, dated October 24, 1929, which states that the torch made by the Toledo Company passes the

(1) Ohio R. 68, bottom.

requirements of the Commission "in reference to this Commission's Order No. B-LJ, Rule F, regarding all common carriers carrying two oil burning torches."

The inference sought to be conveyed by petitioner is that the demand for a torch like that of the patent in suit was created by the passage of state laws requiring their use around parked trucks and busses. As stated by this court in *Diamond Rubber Co. vs. Consolidated Tire Company*, 220 U. S. 428, 442, where a similar argument was made, this is "an inversion of cause and effect, * * *."

(b) Unreliability of Open-Flame Torch

At page 41 of its brief Montgomery Ward reproduces one of the early Toledo circulars, and at page 13 quotes from it the statement that it "will burn all night, anywhere, at any time, in any kind of weather." The evident purpose is not to show that the open-flame torch was in fact reliable, but to reflect on the good faith and integrity of the Toledo Company and its officials, thereby to discredit their claims for efficiency and economy with respect to the patented burner. This purpose appears from the statements at the top of page 40 of the Montgomery Ward brief.

The reliability of the patented burner and the unreliability of the open-flame burner are abundantly established without relying on inferences drawn from statements in advertisements published prior to the date of the invention. Incidentally, McCloskey made the same claims of efficiency for the open-flame torch in his early advertising,⁽²⁾ but he promptly abandoned that torch in favor of a protected wick torch when Withrow and Close

⁽²⁾ N. Y. R. 299.

had shown him that the source of the flame could be protected without interfering with the efficiency of the outside flame as a warning signal.

In Montgomery Ward's attempt to belittle the commercial success of the patented device it fails to mention the fact that more than thirty-five thousand of the patented Economy burners were sold separately by the Toledo Company during the period from 1929 to 1934 to owners of the old Toledo open-flame torch, to be substituted for the burners with which those torches were originally equipped.⁽³⁾ Over eighteen thousand of these separate burners were sold during the year 1929, which brings the total sales of the patented device for that year up to 64,983 as compared with total sales of 39,000 for the old device during the previous year. To give a true picture, the sales of separate Economy burners should be added to the sales noted by petitioner⁽⁴⁾ for the years 1929 to 1934 and deducted from the sales of the old type torches noted for the years 1926 to 1928. The total sales of all old type torches for the three years were 66,751 and the total sales of separate Economy burners for use on these old type torches up to the end of 1934 were 35,361, which left only 31,390 of the old type Toledo torches in use, assuming that none had been lost or destroyed.⁽⁵⁾

Petitioner's table of sales also is in error in that it indicates the first sales of plaintiff's truck flares (Exhibit 19) to have been in 1934. As heretofore noted, these flares were introduced by the Toledo Company in October, 1929, and they were sold continuously thereafter.

(3) The Toledo Company never sold the caps of its burner separately as stated at the top of page 14 of the Montgomery Ward brief. It sold complete Economy burners, intended for substitution for the old Toledo type open-flame burner. These Economy burners consisted of complete units—screw-collar adapter, wick-holder, hood or cap and wick.

(4) Montgomery Ward brief, page 15.

(5) N. Y. R. 25, l. 75 and p. 26, l. 77.

The advance made over the old style open-flame torch strikingly appears from Currie's testimony that upon examining and testing one of Toledo Company's patented torches it became evident that if his company "desired to remain in the competing field we would have to have something as good."⁽⁶⁾

(c) Fuel Economy of the Patented Torch

The Montgomery Ward brief attacks the claims for fuel economy made by the Toledo Company, basing its criticism on the results of indoor tests conducted by Professor Croft. Those tests are open to two criticisms, either one of which is sufficient to show their unreliability for the purposes of determining fuel economy of the patented torch as compared with its predecessor, the open-flame torch. The first criticism is that Professor Croft used the same wick extension ($\frac{3}{8}$ ") for the protected and unprotected wicks, thereby adopting a condition for the open-flame torch which had been found impractical in outdoor use. In an effort to justify the use of only $\frac{3}{8}$ " wick extension in the Croft tests of open-flame burners, it is asserted that $\frac{1}{2}$ " wick extension is all that is necessary, and that this is the extension used in the three-wick torches of the Detroit Street Railways. Total wick exposure is the element which determines fuel consumption and also the ability of the flame to withstand heavy winds and rains. Three wicks extended $\frac{1}{2}$ " each would give more total wick exposure than would an extension of $1\frac{1}{2}$ " for a single wick.

The experience of all three manufacturers of the open-flame torch was the same with respect to wick extension. Mr. Close testified on this subject in the New York case, stating that when his company started out

⁽⁶⁾ N. Y. R. 172, f. 515.

with the open-flame torch they wanted to have the wick extended as little as possible—that common sense dictated that. When complaints began to come in because the torches were being extinguished, they wanted to strengthen the flame and decided that a longer wick exposure would assist in solving that difficulty. After considerable experience in settling complaints and making tests of their own they found that an inch and a half was about the shortest length they could rely on for overnight service. He further stated that as they extended the wick the fuel consumption rose.⁽⁷⁾ As a result of this experience the Toledo Company attached to each open-flame torch sold a yellow tag stating:⁽⁸⁾

“The normal length of exposed wick is about one and one-half inches. Extend wick further for heavy weather conditions.”

The experience of the Dietz Company regarding the necessity for extending the wick of the open-flame torch was the same as that of the Toledo Company. Mr. Currie testified that the wick in the Dietz commercial open-flame wick torch “had to be carried out about an inch and a half.”⁽⁹⁾ The McCloskey circulars reproduced at page 204 of the Ohio record and at page 299 of the New York record show a similar wick extension in the McCloskey open-flame torch.

The recommendation of the Toledo Company regarding wick extension for its patented torch is that the wick should project about one-eighth of an inch.⁽¹⁰⁾

Because these differences in the wick extension requirements for the two types of torches were disregarded

(7) N. Y. R. 48, l. 144.

(8) Ohio Exhibit 6 and N. Y. Exhibit 14.

(9) N. Y. R. 171, l. 513.

(10) N. Y. R. 250, center of page.

in all of the Croft indoor experimental tests, the results shown on the Croft graphs, one of which is reproduced at page 19 of the Montgomery Ward brief, are of no value on the question of relative efficiency of open-flame torches and the patented torch.

The other criticism of the Croft tests is that all his tests of burners with flame guards were made with two of the flame openings in the direct line of the air stream, so that the wind could enter one of these openings and pass directly out of the opposite opening without encountering any obstruction. Based on tests of this character, Professor Croft expressed the opinion that the Toledo Company's Economy burner is less efficient than the Anthes burner.

At page 22 of the Montgomery Ward brief testimony is quoted which, without explanation, indicates an agreement by the parties that the performance of the Economy and Anthes torches is "quite the opposite." This testimony refers to comparative tests which were made by the Toledo Company following the Croft deposition, for the purpose of checking the Croft data. Those tests showed that while the Anthes flare gave slightly greater luminescence than the Economy flare when the flame openings were placed at right angles to the air stream, as in the Croft tests, the Economy flare showed greater luminescence when the flame openings were placed at 45° to the air stream.⁽¹¹⁾ These were indoor tests, but the results regarding fuel consumption were confirmed by outdoor tests of the Economy and Anthes flares made under

(11) The comparative tests of the Economy and Anthes flares here referred to are reported at pages 185 to 188 of the New York Record. For records of other comparative tests of the different types of burners see Ohio R. 185-191; N. Y. R. 47, 307-309.

In the tests conducted by the Electrical Testing Laboratories for the State of Pennsylvania the torches were rotated at the rate of four revolutions a minute in order to simulate changing air conditions.

identical conditions. The tanks were filled with the same quantity of oil and weighed, the wicks similarly adjusted and lighted, and the flares placed outdoors side by side and burned for the same number of hours, after which the flames were extinguished and the devices weighed, from which the amount of fuel consumed per hour was computed. Exhibit 29 in the New York case covers outdoor runs of approximately eight hours each on seven days, beginning February 1, 1938, and ending February 9, 1938. The Economy flare burned an average of 1.637 oz. of kerosene per hour and the Anthes an average of 1.633 oz. per hour. At the same time an open-flame Toledo torch, with 1½" wick extension, burned 4.634 oz. per hour and the Detroit 3-wick torch with ¼" wick extension burned 4.238 oz. per hour.⁽¹²⁾

Dr. Olsen conducted a similar outdoor test of three each of the Economy and Anthes flares placed on a fire escape at the Brooklyn Polytechnic Institute on a very windy day early in March, 1938. The average fuel consumption for the Anthes was 2.05 ozs. per hour and for the Toledo 1.95 ozs. per hour.⁽¹³⁾

It is not without significance that in the chart which Montgomery Ward has reproduced at page 19 of its brief the data relating to the tests made without the flame guard stops at 14 m.p.h. wind velocity, whereas that with reference to the tests of the same burners equipped with flame guards run beyond the limits of the chart. Professor Croft testified that the apparatus used in his tests was capable of developing a wind velocity of 33 m.p.h. and that both the Economy and Anthes torches remained lighted at that maximum wind velocity.⁽¹⁴⁾ He further

(12) N. Y. R. 308, 309.

(13) N. Y. R. 241, f. 722.

(14) N. Y. R. 157, f. 471.

stated that he conducted practically all of his tests below a wind velocity of 10 m.p.h. "because at a slightly higher velocity one of the flares was extinguished without the flame guard. * * *"—thus showing the inadequacy of the short wick extension.⁽¹⁵⁾

(d) The Prior Art Before the Examiner

On page 6 of the Montgomery Ward brief the statement is made that Hathaway No. 147,496 was the only patent before the Examiner. The file history was not offered in evidence in either case. As stated in the answers in the Ohio cases, twenty-two United States patents and five foreign patents were before the Examiner.⁽¹⁶⁾ The wide field from which to select references of the character relied on is indicated by the fact that Defendant's Exhibit N, Book of Patents in the Ohio cases, contains twenty United States patents and Montgomery Ward Exhibits C and D contain thirty patents and six publications, only ten of the references in the two cases being duplicates. It is not surprising that with such a large field to draw from the defendants avoided citing most of the patents which were considered by the Examiner. It is of interest that the prior art references most strongly relied on in the Ohio cases, Almond No. 193,796 and Billingham 181,030, are not relied on at all in the New York case.

(e) Zone of "Comparatively Quiescent Air"

Montgomery Ward contends that the Anthes flare has no zone of "comparatively quiescent air." The Toledo Company's expert, Dr. Olsen, gave the only testimony on this subject. His testimony, which is referred

(15) N. Y. R. 162, f. 486.

(16) Ohio R. pages 9 and 10.

to at the bottom of page 23 of the Montgomery Ward brief, was that "there couldn't be a layer of **quiescent** air."⁽¹⁷⁾ (Emphasis ours.) He testified regarding the presence of a zone of **comparatively** quiescent air, as described in the patent in suit. Referring to the Economy burner, which is manufactured by the Toledo Company under that patent, Dr. Olsen testified (N. Y. R. 196, f. 588):

"Now, I found that this device had a little chamber, I call it a combustion chamber, in the bottom of the cap, and that this is protected, and there are some air holes which are restricted, not too big, so that when you once light it you have a little chamber where a little air is admitted, and which maintains the temperature of the wick to the point where it will give off vapor."

Subsequently testifying regarding both the Economy and Anthes burners, Dr. Olsen said (N. Y. R. 198, f. 593, and p. 199, f. 596):

"Each of these two instruments also had restricted air openings into this combustion zone which I have designated, and therefore it would keep this little flame operating. . . . In each case there was enough air admitted to maintain this flame in the combustion zone which, to my way of thinking, is the actual, the essential part of this device, or at least a very essential part, that they do maintain that flame and under high wind conditions, so I couldn't see any essential difference between them."

There is no zone of **quiescent** air in any of these devices, but below the flame outlets in each of them there is a zone where the air is **comparatively** quiescent, as described in the patent, and this is equally true whether the air inlets are in the sides of the cap or in the flange which supports the cap.

⁽¹⁷⁾ N. Y. R. 91, f. 271.

(f) **Currie's Statement That He Must Have Had in Mind That a Torch Could Be Protected From Rain by Placing a Flat Shield Over the Top**

In support of Montgomery Ward's contention that it required no invention to protect the wick of a signal torch from wind and rain without interfering with the effectiveness thereof as a warning signal, page 16 of its brief, it quotes the testimony of Currie that the thought that he might put a flat shield over the top to keep out the rain must have been in his mind, but that he just didn't do it. This statement by Currie must be interpreted in the light of the fact that following several months of intensive experimentation, he admitted his failure to solve the problem he was working on and had his company place on the market a substantial duplicate of the Toledo open-flame torch, Exhibit 10 in the New York case. The statement referred to was made during Currie's cross examination. He did not state that it occurred to him to place a cover over the top of his Exhibit 37, but that it **must have** occurred to him. He was speculating and not testifying to a fact. While Currie may have known that to place a cover over the wick would protect it from rain, he did not do it, just as Kerwin of the Detroit Street Railways may have known that to place a guard around the sides of the flame would protect it from wind, but he did not do it. Neither Currie nor Kerwin could see how it would be possible to use both a cover and a side guard and still preserve the function of the device as a warning signal. It remained for these patentees to discover and disclose to the world how this could be done, after which Currie's company and McCloskey, Toledo Company's only competitors in the manufacture and sale of torches for use

as warning signals, adopted plaintiff's solution of the problem and, as stated by Judge Hahn in the Ohio cases, there has been no substantial improvement since.

The statement at the top of page 47 of the Montgomery Ward brief that "Currie of the Dietz Company was **half-heartedly** experimenting in an attempt to get something better than the open-flame Toledo torch" is not supported by Currie's testimony. On the contrary, he testified that he experimented with an open-flame Toledo torch "for the better part of that year, the year 1928 I think it was."⁽¹⁾ And on cross examination he testified (N. Y. R. 173, f. 519):

"In 1928 I started experimenting, trying to improve this open-flame torch. The experiments that I made were outdoor tests, both around the factory, and then we have a cottage out about twenty miles, out at a lake, and I was experimenting there every day, principally at night only when I got home. I had the various structures made for me."

He also testified:

"Our experimentation did not produce a structure which I regarded as better than the open wick type of torch that we ultimately brought out."
(N. Y. R. 171, f. 513.)

(g) The Anthes-Rutz Combination (New York Exhibit L)

Some fifteen million of the Rutz flash igniters were sold, and open-flame pot torches had been in use as warning signals around excavations and obstructions since time out of mind. The fact that they would be extinguished by hard winds and heavy rains must have been known to thousands, yet it remained for these patentees

⁽¹⁾ N. Y. R. 168, f. 503.

to discover that by placing a hood or cap over the exposed end of the wick with suitable provision for the inlet of air and the escape of hydrocarbon vapors the flame could be maintained in all kinds of weather, without enclosing that portion of the flame which acts as a warning signal. It did not occur to Currie when, as factory manager of the Dietz Company he was endeavoring over a period of several months to discover means for protecting the flame of these outdoor warning signals, to try placing the Rutz cap, with which he was thoroughly familiar, over the end of the wick.

No such combination had ever been made or suggested prior to the issuance of the patent in suit, and the fact that Anthes' expert was able to find a Rutz cap which could be fitted over the wick holder of the Anthes flare (first made in 1934 under a license from the Toledo Company), and thus accomplish in some degree the benefits and advantages of the torch of the patent in suit, does not establish lack of invention in the discovery that new and theretofore unknown beneficial results could be obtained by the structure of the patent in suit.

(h) The Russian Patent to Malcov

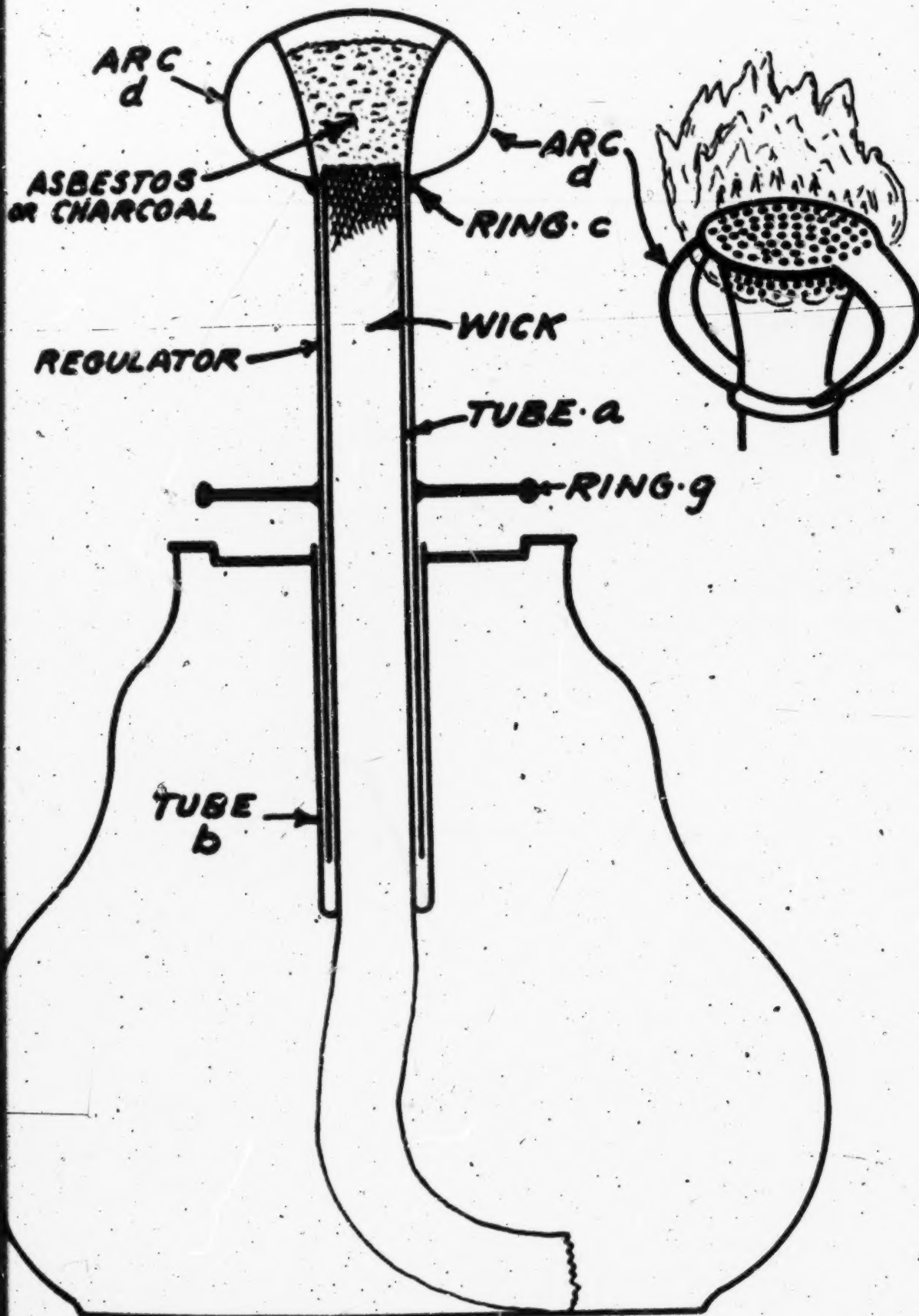
As pointed out in our main brief, the experts were unable to state definitely what this patent discloses or how it was intended to work. Our interpretation of this patent is that the funnel-shaped element shown in Figs. 2 and 3 is a container for "asbestos, crushed charcoal or some other incombustible material readily conducting liquid," which covers the wick and extends to within one-fourth inch of the top of the funnel, thus leaving a free space for the vapors to accumulate and pass out through small perforations in the dome and upper portion of the

funnel, to burn entirely outside the burner. As stated in the patent the two arcs *d d* do not constitute an essential part of the burner. In other words, the burner would operate as intended, without these arcs. Remove them from Montgomery Ward Exhibit I and no burner would remain. Furthermore, the exhibit omits entirely the tubes *a* and *b*, which the patent states are "for the purpose of preventing the gas, which is fairly heavy, from passing downward (and escaping), as otherwise not all of the gas would pass through the openings provided in the upper portion and would not combust completely, but would volatile without usefulness." The Malcov patent does not state what fuel was intended nor what the burner was to be used for. Probably the fuel was alcohol, which has a heavy vapor, and the burner was intended for heating by a blue alcohol flame, and not for lighting.

Exhibit I in the New York case does not respond to the patent description. An interpretation of the disclosure which does respond to all parts of the description is shown on the opposite page.

(i) Almond Patent No. 193,796

Respondents in the Ohio cases select the Almond patent No. 193,796 as the best reference. This was also the selection of their expert. The brief calls attention to the testimony of the expert that he had tried Exhibit G, offered as representative of the Almond burner, and found that it burned just the same as the others. The character of that trial appears from the cross examination of the expert at the bottom of page 129. It was made in a vacant lot adjoining a hotel in Toledo, surrounded by buildings. No evidence was submitted regarding weather conditions or wind velocity, the witness merely

MALCOV BURNER

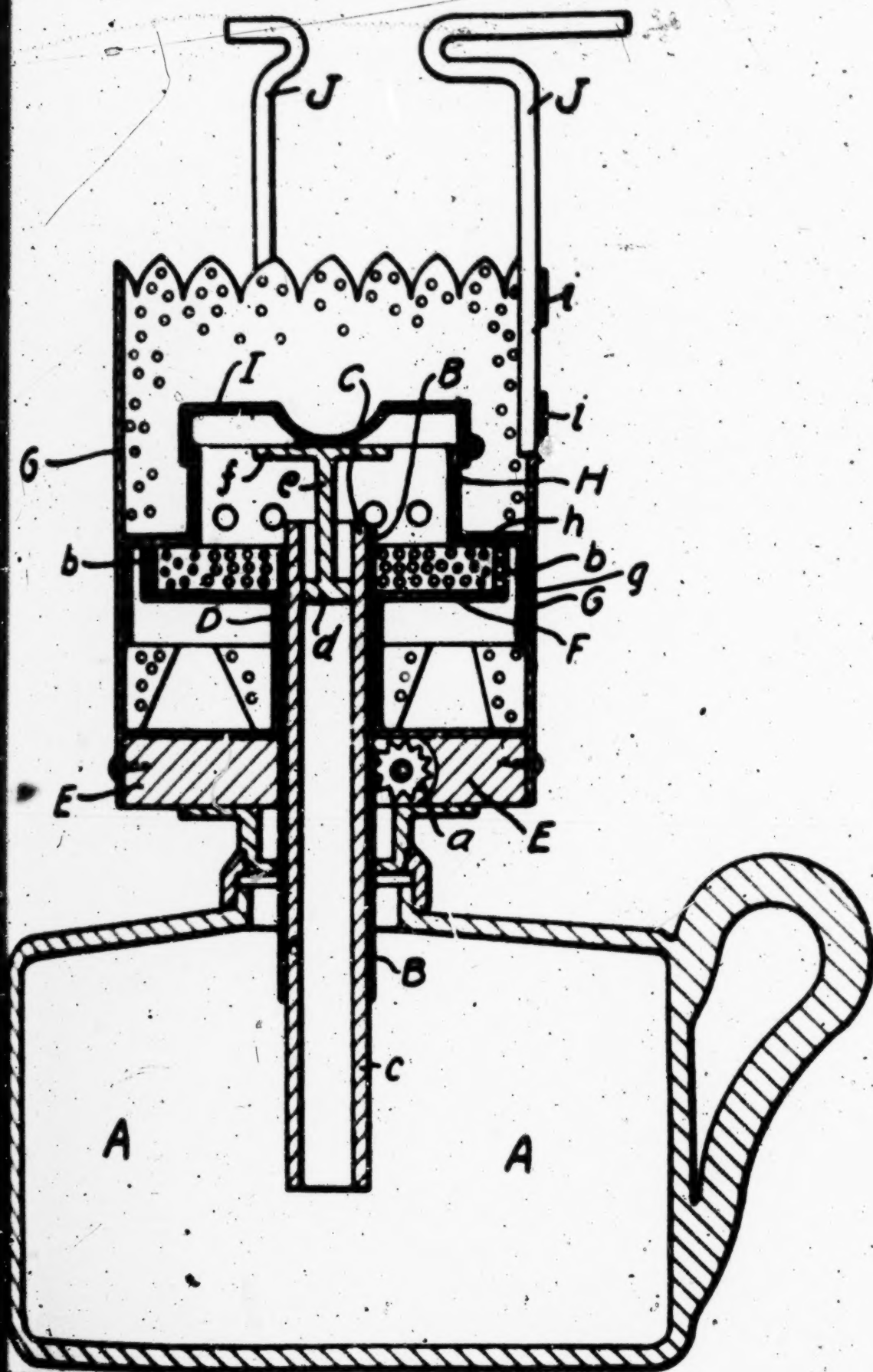
stating that they "were in a pretty drafty place." Respondents' Exhibit G, thus tested, represents only a small portion of the Almond device which has been lifted from its intended environment and has been modified with respect to both flange and openings, to suit the purposes of the expert, who admitted that he "never tried this Almond device made up in accordance with the patent drawings." The device he tested did not have the shield G of the Almond patent, without which the patentee states "the degree of combustion and good heating-flame will not be obtained." The expert further testified that he had no knowledge of how the Almond device would operate "as a vapor burner," for which it was intended by Almond.⁽²⁰⁾

There is no justification in the Almond patent for the statement at the top of page 10 of Ohio Respondents' brief that the device will become an illuminating lamp on removing the tube G. On the contrary, the patent indicates that this tube should not be removed. At page 25 of Respondents' brief they have shown the Almond heater in the form in which they state it would become an illuminating lamp, with the tube G removed. A better understanding of the Almond device will be obtained from an enlargement of Fig. 1 of the patent drawing, shown on the opposite page. The parts which Respondents have lifted out of this device and call the flame guard of the patent in suit are colored red.

The lack of pertinency of the Almond heating burner is reflected by the fact that petitioner's counsel and expert in the New York case made no reference to it during the hearing in the District Court other than to offer a copy of the patent as one of those referred to in the Sixth Circuit opinion.

(20) See cross examination, Ohio R. 109-116.

ALMOND BURNER



The answer in the New York case (R. 12) refers to the Ohio cases and states "the fact to be that on the trial of said suits the defendants therein did not offer in evidence the pertinent prior art, nor did the court consider or have before it the pertinent prior art bearing on the validity of said letters patent; * * *."

(j) Billingham Patent No. 181,030

This is the second choice of respondents in the Ohio cases as showing anticipation. This patent is not referred to in the Sixth Circuit opinion and is not included in the book of prior art patents in evidence in the New York case as Defendant's Exhibit C. A catalog page illustrating this device as manufactured by the owner of the Billingham patent is reproduced at page 215 of the Ohio record, and a street lamp torch made in exact accordance with this illustration is in evidence in the Ohio case as Plaintiff's Exhibit 32. Mr. Withrow tested this exhibit under various conditions, using sperm oil as recommended by the manufacturer and also kerosene as used in the Withrow and Close torch. He found it impossible to so adjust the wick that the flame would emerge from the openings in the casing, and that when used as shown in the catalog cut the device operated precisely as stated in Heath patent, 66,021, for a similar device, as follows (Ohio R. 229):

"When the burner (street gas lamp) is to be lighted the apparatus (of the Heath patent) is inserted through the bottom of the lamp, till its end, coming in contact with the handle, turns it over into the position represented in dotted lines. The cock of the burner is thus opened, and the gas escaping therefrom, entering through the apertures b and b' (of the Billingham lighter), comes in contact with the flame of the lamp C and is thereby lighted."

(k) Other Patents Referred to by Ohio Respondents

Although copies of the Blake, Heston and Kahn patents are included among the prior art patents offered in the New York case, they were not referred to by the expert in that case. They were offered merely because they were mentioned in the Sixth Circuit opinion. The Reekie patent, also referred to in that opinion, was not even offered in the New York case. We note, however, that the Kahn patent is for a flash igniter similar to the Rutz patent relied on in the New York case, and what has been said in our main brief regarding Rutz applies equally to Kahn.

Wall patent 228,497 for a mill lamp is referred to repeatedly in petitioner's brief in the New York case for the purpose, as we understand, of showing that the patent in suit was not the first to disclose the broad combination of a tank for fuel, a wick, and some kind of a guard for the flame. Petitioner does not contend that this mill lamp would remain lighted in even a moderate wind if used outdoors. It contains three separate wick tubes and wicks, only the center one (marked E) of which is provided with the part which petitioner refers to as a flame guard. An air flue H leads from this central burner down through the fuel container and out of the side of the tank near the bottom. The so-called flame guard is referred to as a "detachable burner," and is entirely open at bottom and top, with no side openings whatever. In fact, it closely resembles the ordinary burner used in lamps and lanterns, minus the glass chimney. The patent states that when "the lamp is used for a moving light the wicks in the tubes B and C are lighted." These two wicks are entirely unprotected. The lack of pertinence of the Wall patent appears from the

fact that it was not set up as a reference in any of the answers and was not referred to by any of the experts.

II. ARGUMENT

The invalidity of the patent in suit is asserted on three grounds. Respondents in the Ohio cases and petitioner in the New York case all assert the defenses of anticipation and lack of invention, but on different grounds, and petitioner in the New York case asserts that claims 2 and 5 are void as covering aggregations rather than true combinations. These three defenses will be briefly considered.

(a) The Patent in Suit Is Not Anticipated

In the Ohio cases respondents assert that the patent to Almond anticipates all the claims in suit and attempt is made to apply the wording of the claims to different portions of the Almond structure. The totally different purposes for which these devices were designed and their wholly divergent uses (if in fact the Almond device ever was used) are disregarded and the claims treated as mere assemblies of words. Almond is for an indoor heating device, whereas the patent in suit is for an outdoor construction torch. To further distinguish from such non-analogous prior art devices each claim in suit opens with the limiting clause "In a device of the class described" or "A burner for a construction torch adapted to emit a luminescent flame." This same defense was urged in the Sixth Circuit Court of Appeals and was disregarded in the opinion of that court.

The classic statement of Mr. Justice Bradford in the opinion of this court in *Consolidated Valve Co. vs. Crosby Valve Co.*, 113 U. S. 157, is pertinent. He stated (p. 170).

"In regard to all of the above patents, adduced against Richardson's patent of 1866, it may be generally said, that they never were, in their day, and before the date of that patent, or of Richardson's invention, known or recognized as producing any such result as his apparatus of that patent produces, as above defined. Likenesses in them, in physical structure, to the apparatus of Richardson, in important particulars, may be pointed out, but it is only as the anatomy of a corpse resembles that of the living being."

Petitioner in the New York case asserts that claims 2 and 5 are anticipated by the Russian patent to Malcov and claims 11 and 12 by the patent to Rutz for a flash igniter. The remarks in connection with Almond are equally applicable to these patents. "Mere literalism in statement of the claim should not defeat a meritorious patent."⁽²¹⁾

In *Lakewood Engineering Co. vs. Walker*, 23 Fed. (2) 623 (C. C. A. 6), the patent was for "a road-surfacing device, comprising a flat pliable strap, and handle bars at the ends thereof." In holding the patent valid, the court said (p. 623):

(21) *Belber Trunk & Bag Co. vs. Seward Trunk & Bag Co.*, 279 Fed. 82, 83 (C. C. A. 2). See also the opinion of the Seventh Circuit Court of Appeals in *Nordberg Mfg. Co. vs. Woolery Machine Co.*, 79 Fed. (2d) 685, 690, where the court stated:

"The District Court's ruling in sustaining the claims in suit was explicitly based upon the principle that the first clause of the claims, 'a machine of the character described' should be constantly considered in determining the question of anticipation. That premise is sound. By it the scope of the patent is limited, and by it the patent is protected against alleged anticipations. This court has held claims valid in which elements were literally met in some non-analogous use device, but where the reference was intended to operate for a different purpose and object, and did not answer the introductory clause of the claim. *Duncan vs. Stockham* (C. C. A.) 204 F. 781; *Schram Glass Mfg. Co. vs. Homer Brooke Glass Co.* (C. C. A.) 249 F. 228; *Benoit vs. Wadley Co.* (C. C. A.) 54 F. (2d) 1041. These decisions are supported by the following: *Seymour vs. Osborne*, 11 Wall. 516, 20 L. Ed. 33; *Consolidated Roller-Mill Co. vs. Walker*, 138 U. S. 124, 11 S. Ct. 292, 34 L. Ed. 920."

"We have little difficulty with the earlier patents and devices which are set up as anticipations or as inconsistent with the existence of any invention in what Walker did. They do not respond to the letter of the claims, because they are not road-surfacing devices; nor to its spirit, because they are in fields too far away."⁽²²⁾

(c) The Patent in Suit Is Not Invalid for Lack of Invention

Opponents' arguments of invalidity for lack of invention over the prior art are directed to efforts to show that with the disclosure of the patent in suit before him a mechanic would have no difficulty in combining with the old open-flame oil burning wick torch a cap or hood taken from some prior art patent or structure, in such manner as to accomplish in some degree the results and advantages obtained by the patented torch and by each of the torches charged to infringe.

This argument ignores the rule, established by this court in early cases and frequently applied, that invention may reside in the conception or discovery that a new and useful result may be obtained by combining elements which in themselves may be either new or old, even though it may require no invention to so combine them after the road has been marked.

National Cash Register Co. vs. Boston Cash Indicator & Recorder Co., 156 U. S. 502, 514, 515.

(22) In a footnote to the opinion, the court said:

"Many a claim to a device or an article has been sustained, because its reference to its purpose or use was thought enough to distinguish it patentably from earlier devices, which would be covered by its otherwise too broad words of structural description—e.g., an old continuous cement lining claimed in a pulp digester, *Manning vs. American Co.*, (C.C.A.6) 228 F. 700; an old bituminous composition claimed as a street pavement, *Warren vs. Onizco*, (C. C. A. 6) 166 F. 309; an old compound claimed as a resistance element, *General Electric Co. vs. Hoshins Co.*, (C. C. A. 7) 224 F. 464."

Hobbs vs. Beach, 180 U. S. 383, 392.

Traitel Marble Co. vs. U. T. Hungerford
Brass & Copper Co., 18 F. (2d) 66, 68
(C. C. A. 2).

H. C. White Co. vs. Morton E. Converse &
Son Co., 20 F. (2d) 311, 312-313 (C. C.
A. 2).

Hookless Fastener Co. vs. G. E. Prentice
Mfg. Co., 68 F. (2d) 940, 941 (C. C.
A. 2).

The rule was applied by this court in the *Cash Register Company* case as follows, in an opinion by Mr. Justice Brown (156 U. S. 502, 514, 515):

"It did, however, require thought to conceive the idea (1) that a remedy for the existing defects in the machine lay in the independent operation of the wing; and (2) that such operation could be secured by a mechanical connection with the keys. Given these conceptions, it was more a matter of mechanical skill than of invention to devise such connection, since a similar train of mechanism had been operated by the keys for other purposes. . . . Indeed, this use of the connecting mechanism can hardly be termed analogous to such as similar mechanisms had been previously used for; but even if it were, the results are so important, and the ingenuity displayed to bring them about is such that we are not disposed to deny the patentees the merit of invention."

There is no evidence in the Ohio record which justifies the assumption that a mechanic skilled in the art and familiar with the prior structures relied on would have recognized that they could be combined to produce a solution of the problem confronting Withrow and Close, and the record in the New York case shows beyond question that there is no real basis for such an assumption.

The negative tests of invention set forth in the cases cited on page 26 of the Montgomery Ward brief and the discussion, under point III of that brief serve to support our argument on the question of invention. In each of the cited cases where the question of invention was considered this court found that the advance ascribed to the patent there in suit was in fact to be found in the teachings of the prior art.

(c) Claims 2 and 5 Are Not for Aggregations

This defense is not set up in the answers in the Ohio cases, nor is it urged by respondents in those cases. The defense, as urged by petitioner in the New York case, disregards the controlling facts (1) that by combining a torch body and a flame guard of the general type shown in the Rutz patent the patentees Withrow and Close have produced a new and useful result, and (2) that the Rutz cap is only one of a number of elements which are combined to make the Rutz flash igniter. This latter fact clearly appears from the Rutz drawing as well as from the claims of that patent. Claim 1, one of the broadest of the Rutz claims, calls for the following elements in combination in a flash igniter:

- (1) a torch head having a crown tip provided with radial ducts grouped to form a single pilot-light,
- (2) a feed-pipe for the torch-head,
- (3) a valve therefor having a by-pass for supplying a constant flow of gas to said torch-head to form a pilot-light, and
- (4) a cylindrical dome provided with firing ports in radial alinement with the tip apertures but upon a slightly higher plane than said tip apertures.

As stated by defendant's expert in the New York case he lifted this fourth element of Rutz "from one purpose to another" in making the device offered in evidence as Exhibit L.

To so combine old elements as to perform new functions and produce new results has always been recognized as constituting invention, within the meaning of the patent statutes.

Keystone Mfg. Co. vs. Adams, 151 U. S. 139, 144.

Leeds & Catlin vs. Victor Talking Machine Co., 213 U. S. 301, 318.

Same vs. Same, 213 U. S. 325, 332.

Diamond Rubber Co. vs. Consolidated Rubber Tire Co., 220 U. S. 428.

In the latest of these cases, involving the Grant tire patent for a combination of several elements, each old and well-known in the tire industry, the court, in an opinion by Mr. Justice McKenna, stated (pp. 442, 443):

"To what quality the utility of the tire may be due will bear further consideration, if for no other reason than the earnest contentions of counsel. Aside from those contentions and the ability by which they are supported, we might point to what it does as a demonstration of its difference from all that preceded it, that there is something in it, attribute or force, which did not exist before—something which is the law of its organization and function, and raises it above a mere aggregation of elements to a patentable combination. And we may say in passing the elements of a combination may be all old. In making a combination the inventor has the whole field of mechanics to draw from. **Leeds & Catlin vs. Victor Talking Machine Co., 213 U. S. at page 318.**"

In *Keystone Mfg. Co. vs. Adams* the same elements were combined as in older patents, the movement of one element—a revolving shaft with wings or protuberances—being reversed to produce a different mode of operation with improved results. In holding the patent valid the court stated, in an opinion by Mr. Justice Shiras (p. 144):

“Where the patented invention consists of an improvement of machines previously existing, it is not always easy to point out what it is that distinguishes a new and successful machine from an old and ineffectual one. But when, in a class of machines so widely used as those in question, it is made to appear that at last, after repeated and futile attempts, a machine has been contrived which accomplishes the result desired, and when the Patent Office has granted a patent to the successful inventor, the courts should not be ready to adopt a narrow or astute construction, fatal to the grant.”

Petitioner relies principally on the decision of this court in *Lincoln Engineering Co. vs. Stewart-Warner Corporation*, 303 U. S. 545, to support the argument that the claims are for an aggregation of old elements⁽²¹⁾. This decision must be considered in the light of the controlling facts there found to be present.

1. The improvement was directed solely to a single element of an old combination.
2. No new result was accomplished.
3. No change was made in the combination which

(21) Incidentally, the decision of this court in *Carlton vs. Boker*, 17 Wall 463, is cited and quoted from in connection with this same argument to demonstrate that it was common knowledge as early as 1872 to convey heat to the oil by means of the wick tube. However, this decision warned against using such a construction in connection with a kerosene burning torch such as that of the patent in suit. The sentence following the quotation appearing in petitioner's brief, page 40, reads: "Such an arrangement as this with petroleum (kerosene) would have produced a speedy explosion." If this decision can be said to have taught the patentees anything, it was to avoid the construction which they adopted.

affected the operation of the separate elements or the result produced by them as a whole.

4. The alleged invasion of the patent monopoly consisted in the manufacture and sale of the separate old unimproved elements for use with other elements of the patented combination (including the novel one) supplied by the patent owner.

The real point of the decision is believed to have been stated in the last paragraph of the opinion, as follows (p. 552):

"We conclude that Butler's effort, by the use of a combination claim, **to extend the monopoly of his invention** of an improved form of chuck or coupler **to old parts or elements** having no new function when operated in connection with the coupler renders the claim void." (Emphasis ours.)

Here the patent is criticized because some of its claims include in combination the torch body which is the container for the fuel. We submit that this criticism is unjustified because a new result has been realized to which each of the elements, including the torch body, contributes. This is the first time that these elements were so combined as to produce the accomplished result, which is highly useful and not accomplished by any prior art structure. This fact alone distinguishes the instant cases from the *Lincoln Engineering* case, where the result as well as the combination of elements was old.

No attempt is here being made to extend the monopoly of this invention to the torch body sold separately, or to control the sale of any other element of the combination.

Petitioner although relying on the *Lincoln Engineering* case to defeat the patent does not follow the practice there approved by selling the unpatented torch body or the old open-flame torch.

(d) Cases on Unitary Structures

The cases cited in the Second Circuit opinion on the subject of "unitary structure" are criticized because they relate to accountings for patent infringements. The same rule has been applied in many cases involving questions of validity.

Bates vs. Coe, 98 U. S. 31, 40.

Loom Co. vs. Higgins, 105 U. S. 580, 591.

H. Ward Leonard, Inc., vs. Maxwell Motor Sales Corp., 252 Fed. 584, 593 (C. C. A. 2).

Sachs vs. Hartford Electric Supply Co., 47 Fed. (2d) 743, 748 (C. C. A. 2).

(e) The Cases Are Properly Presented Jointly on the Question of Validity

The opposing briefs suggest an impropriety on our part in presenting these cases jointly on the question of validity of the patent. It is believed that this treatment will not only facilitate the consideration of the cases by counsel and the court, but that it is within the approved practice of this court referred to in *Smith vs. Hall*, 301 U. S. 216, 218-219, and cases therein cited.

We respectfully submit that the decision of the Second Circuit Court of Appeals should be affirmed and those of the Sixth Circuit Court of Appeals should be reversed.

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